

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER K. DAVIES,
JOHN D. SCHOFIELD and
JOHN M. MCCARTHY

Appeal No. 1997-0666
Application 08/338,830

ON BRIEF

Before JOHN D. SMITH, WARREN, and LIEBERMAN, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

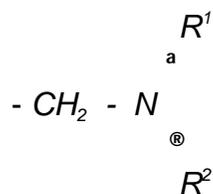
This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 2 through 5, 8 through 10 and 12.

Representative claim 12 is reproduced below:

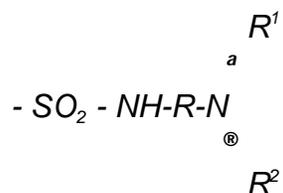
12. A composition comprising

(a) a mixture of copper phthalocyanines containing on average, from 0.1 to 3 methyl groups per phthalocyanine nucleus; and

(b) a deflocculating agent comprising a copper phthalocyanine containing up to four basic groups selected from those of Formulae (1) and (2),



Formula (1)



Formula (2)

wherein,

R¹ & R² are each independently H or C₁₋₄-alkyl; and

R is selected from alkylene, alkenylene and cycloalkylene.

The references of record relied upon by the examiner are:

Leister et al. (Leister)	3,729,330	Apr. 24, 1973
Barraclough et al. (Barraclough)	4,152,171	May 1, 1979

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Barraclough combined with Leister.

We reverse.

The subject matter on appeal is directed to pigment compositions comprising (a) a mixture of copper phthalocyanines (CuPCs) containing, on average, from 0.1 to 3 methyl groups per Pc nucleus and (b) a basic CuPc deflocculating agent. Appellants have found that the presence of methyl groups in a mixture of CuPCs, particularly where unsubstituted CuPc in alpha form is present, functions to inhibit the tendency of alpha-form CuPc to recrystallize in the presence of solvents, thus inhibiting a decrease in color strength and a bathochromic hue shift, on storage. See appellants' specification at page 2, first full paragraph and the brief at page 3. With respect to appellants' claimed component (a), appellants explain that such a mixture of methyl-CuPc may be composed of CuPCs having different numbers of methyl groups. For example, each methyl-CuPc in the composition may contain 1, 2, 3 or 4 methyl groups on the phthalocyanine (Pc) nucleus and a typical composition may contain any or all of these together with CuPc which is free from methyl groups. See the specification at page 2, third full paragraph. Appellants also point out that another essential feature, as defined in the claim, is the combination with the copper phthalocyanine mixture of a deflocculating agent which appellants describe as a basic CuPc containing up to four basic groups selected from the Formula (1) and Formula (2) as set forth in independent claim 12. Appellants' pigment compositions find use in paints and plastics.

As evidence of obviousness of the herein claimed invention, the examiner relies on the combined teachings of Barraclough and Leister. In traversing the stated rejection, appellants argue that neither relied upon reference discloses the use of appellants' basic CuPc component (b) as a deflocculating agent for any purpose, much less in combination with appellants' component (a) mixture of a methylated copper phthalocyanines.

Respecting appellants' component (b) deflocculating agent, we observe that the examiner, for the first time in the prosecution of this application, indicated (Supplemental Answer at page 2) that the claim language defining appellants' deflocculating agent as containing "up to four basic groups" selected from Formulae (1) and (2) includes "zero basic groups." Thus, without further explanation, the examiner apparently now considers component (b) of the appealed claims as covering any copper phthalocyanine deflocculating agent. In light of appellants' specification and the prosecution history of this application, we do not find the examiner's claim construction to be reasonable. In the third paragraph of page 3 of the specification, appellants indicate that a preferred deflocculating agent is a phthalocyanine, especially CuPc, carrying acidic or basic groups. The specification goes on to state that the deflocculating agent "preferably contains up to" four ... basic groups "such as" the groups defined by Formula 1 and Formula 2 of the appealed claims. Although the claim language "up to" includes zero as a lower limit, read in light of the other portion of the paragraph which indicates that such deflocculating agents are especially "CuPc, carrying ... basic groups," we read the claims as the appellants have construed and argued them, i.e., as requiring the

specific basic groups set forth in appealed claim 12, i.e., the Formula 1 and Formula 2 groups. This is consistent with appellants' construction of the claims as evident from their description of the invention in the Brief at page 3 wherein they argue that an essential feature of the invention is the use of a deflocculating agent which is a basic CuPc containing up to four basic groups selected from the formulas in question.

Further, respecting the issue regarding appellants' claimed component (b) deflocculating agents, the examiner contends that the prior art reference to Leister “suggests the genus of the deflocculating agents to which the instant deflocculating agents belong.” See the Answer at pages 9 and 10. However, the fact that a claimed species or subgenus is encompassed by prior art genus is not sufficient by itself to establish a prima facie case of obviousness.

The examiner has also contended that the “instant deflocculating agents were notoriously well-known in the art for preventing flocculation of CuPc pigments.” See the Answer at page 5. It is not uncommon that the rationale supporting an obviousness rejection is based on either common knowledge in the art or “well-known” prior art. As set forth in the MPEP § 2144.03, (6th ed., Rev. 2, July 1196; 2100-115), an examiner may take official notice of facts outside the record so long as such facts are capable of “instant and unquestionable demonstration” as being “well-known” in the art. Having been challenged by appellants in this prosecution to provide factual support for his contention that appellants' specifically claimed deflocculating agents are notoriously well known in the art, the examiner's failure to provide

such objective evidence demonstrates that such facts are not capable of “instant and unquestionable demonstration” as being “well-known” in this art.

Accordingly, in light of the above, the simple fact here on appeal is that neither of the examiner's relied upon references shows or suggests appellants' component (b) for use as a deflocculating agent for any purpose, much less than the specific purpose set forth in appellants' claimed composition. Thus, the combination of references applied by the examiner does not result in the claimed composition. See Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439-40 (Fed. Cir.), cert. denied, 489 U.S. 825 (1988)(a structure created from the combined teachings of the prior art references “would, in any event, fall short of the invention” defined by the claims).

The decision of the examiner is reversed.

REVERSED

John D. Smith)
Administrative Patent Judge)
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)
Charles F. Warren) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
Paul Lieberman)
Administrative Patent Judge)

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